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FILE NO. A34084-PCT-USA-A/ 066031.0147
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kaempfer et al.
Serial No. : 09/801,371 Examiner: Whiteman, B.
Filed : March 7, 2001 Group Art Unit: 1635
For : REGULATION OF GENE EXPRESSION THROUGH
MANIPULATION OF mRNA SPLICING AND ITS USES

#18/K.T.
8/21
E

RESPONSE TO RESTRICTION REQUIREMENT

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231

August 7, 2002
Date of Deposit

Alicia A. Russo
Attorney Name


Signature

46,192
PTO Registration No.

August 7, 2002
Date of Signature

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is being filed in response to the Office Communication dated April 9, 2002. Applicants request a three-month extension of time and enclose the fee required under 37 C.F.R. §1.17(a)(3). Applicants respectfully request reconsideration of the above-identified application in light of the amendments and remarks presented herein.

NY02:395676.1

IN THE CLAIMS

Please **cancel** claims 32-46 and 50 without prejudice.

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REMARKS

This paper is being filed in response to the Office Communication dated April 9, 2002. Applicants request a three-month extension of time and enclose the fee required under 37 C.F.R. §1.17(a)(3). Applicants respectfully request reconsideration of the above-identified application in light of the amendments and remarks presented herein.

Claims 1-50 are pending. Claims 32-46 and 50 have been cancelled.

The Examiner has stated that the claims of the present application contains distinct inventions, which he has divided into the following six groups:

Group I: Claims 1-31 and 47-49, drawn to a cis-acting nucleotide sequence;

Group II: Claims 32-33 and 50 drawn to a method of producing a recombinant enzyme, hormone, cytokine, structural protein, or industrially or agriculturally applicable protein (an election of one of an enzyme, hormone, cytokine, etc., is further required if Group II is selected);

Group III: Claims 34-35, 37-38 and 43-45, drawn to a method of regulating gene expression at the mRNA splicing level;

Group IV: Claims 34, 36, and 43-45, drawn to a method of regulating gene expression at the mRNA splicing level (differs from Group III in step (a) due to the use of a trans-dominant negative mutant of PKR α 6);

Group V: Claims 34, 36, and 43-45, drawn to a method of regulating gene expression at the mRNA splicing level (differ from Groups III and IV in step (a) due to the use of a vector expressing viral proteins); and

Group VI: Claims 43, 44 and 46, drawn to an *ex vivo* method of providing a therapeutic protein to a mammal.

The Examiner contends that Applicants must elect one group to be examined in the present application. In response, Applicants elect to pursue the claims of Group I (claims 1-31 and 47-49) without traverse and without prejudice to pursuing the cancelled claims of Groups II-VI in one or more divisional applications.

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Applicants have enclosed the fee for a three-month extension of time as required under 37 C.F.R. §1.17(a)(3). Applicants do not believe that any additional fee is required for this filing. Nevertheless, the Commissioner is hereby authorized to charge any fees required for this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. Two copies of this page are enclosed.

Respectfully submitted,

August 7, 2002



Rochelle K. Seide
Patent Office Reg. No. 32,300

Alicia A. Russo
Patent Office, Reg. No. 46,192

Attorneys for Applicants
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New York, NY 10112
(212) 408-2500

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Please type a plus sign (+) inside this box → ☒**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/801,371	
	Filing Date	March 7, 2001	
	First Named Inventor	Raymond Kaempfer	
	Group Art Unit	1635	
	Examiner Name	Whiteman, Brian A.	
Total Number of Pages in This Submission	8	Attorney Docket Number	A34084-PCT-USA-A

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks <input type="checkbox"/>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	BakerBotts LLP 30 Rockefeller Plaza New York, NY 10112	
Signature		Att Name: Alicia A. Russo PTO Reg: 46,192
Date	August 7, 2002	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: <u>August 7, 2002</u>		
Typed or printed name	Alicia A. Russo	
Signature		Date August 7, 2002

BAKER BOTTS LLP

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FEE TRANSMITTAL
for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT

(\$ 460)

Complete if Known

Application Number	09/801,371
Filing Date	March 7, 2001
First Named Inventor	Raymond Kaempfer
Examiner Name	Whiteman, Brian A.
Group Art Unit	1635
Attorney Docket No.	A34084-PCT-USA-A

TECH CENTER 600/2900

METHOD OF PAYMENT

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number

02-4377

Deposit
Account
Name

Baker Botts LLP

- ☒
- Charge Any Additional Fee Required
-
- Under 37 CFR 1.16 and 1.17

- ☐
- Applicant claims small entity status.
-
- See 37 CFR 1.27

- 2.
- ☒
- Payment Enclosed:

- ☒
- Check
- ☐
- Credit card
- ☐
- Money
-
- Order
- ☐
- Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

Fee (\$)	Fee (\$)	Fee Description	Fee Paid
740	370	Utility filing fee	
330	165	Design filing fee	
510	255	Plant filing fee	
740	370	Reissue filing fee	
160	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0)

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	20** = 0	0	0
Multiple Dependent Claims	3** = 0	0	0

Large Entity Small Entity

Fee (\$)	Fee (\$)	Fee Description
18	9	Claims in excess of 20
84	42	Independent claims in excess of 3
280	140	Multiple dependent claim, if not paid
84	42	** Reissue independent claims over original patent
18	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ 0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee (\$)	Small Entity Fee (\$)	Fee Description	Fee Paid
130	65	Surcharge - late filing fee or oath	
50	25	Surcharge - late provisional filing fee or cover sheet	
130	130	Non-English specification	
2,520	2,520	For filing a request for <i>ex parte</i> reexamination	
920*	920*	Requesting publication of SIR prior to Examiner action	
1,840*	1,840*	Requesting publication of SIR after Examiner action	
110	55	Extension for reply within first month	
400	200	Extension for reply within second month	
920	460	Extension for reply within third month	460
1,440	720	Extension for reply within fourth month	
1,960	980	Extension for reply within fifth month	
320	160	Notice of Appeal	
320	160	Filing a brief in support of an appeal	
280	140	Request for oral hearing	
1,510	1,510	Petition to institute a public use proceeding	
110	55	Petition to revive - unavoidable	
1,280	640	Petition to revive - unintentional	
1,280	640	Utility issue fee (or reissue)	
460	230	Design issue fee	
620	310	Plant issue fee	
130	130	Petitions to the Commissioner	
50	50	Processing fee under 37 CFR 1.17(q)	
180	180	Submission of Information Disclosure Stmt	
40	40	Recording each patent assignment per property (times number of properties)	
740	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
740	370	For each additional invention to be examined (37 CFR § 1.129(b))	
740	370	Request for Continued Examination (RCE)	
900	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 460)

SUBMITTED BY

Name (Print/Type)	Alicia A. Russo	Registration No. (Attorney/Agent)	46,192	Telephone	(212) 408-2627
Signature	<i>Alicia A. Russo</i>	Date	August 7, 2002		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Title: REGULATION OF GENE EXPRESSION THROUGH MANIPULATION OF mRNA SPLICING AND ITS USES

Use Space Below for Additional Information: